

CASE PH/5-31140A

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January 4, 2005
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
GLOCK ET AL.

Art Unit: 1616
Examiner: QAZI, SABIHA NAIM
Confirmation No.: 4690

APPLICATION NO: 10/070,936

FILED: AUGUST 9, 2002

FOR: HERBICIDAL COMPOSITION

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REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Sir:

This paper is in response to the Office Action mailed October 6, 2004, finally rejecting claims 1-7 of the above-referenced application. Reconsideration and withdrawal of this rejection is requested for the following reasons:

Comments will be in response to the page number and paragraph number used by the Examiner in this Office Action.

Page 2, paragraph 3. The Examiner states that claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,410,480 (Muhlebach et. al.) and WO 98/13361 (Tobler et al.). The Examiner also states that the arguments presented by Applicants are irrelevant because they refer to WO 99/47525 and WO 96/21652 which were not cited.

WO 99/47525 is equivalent to U.S. Patent 6,410,480 (Muhlebach et al.). Applicants have mistakenly referred to WO 96/21652 instead of WO 98/13361. However the comments relative to Muhlebach et al. are correct, and the comments relative to WO '652 should be applied to WO '361.

With reference to the Muhlebach et al. citation, Muhlebach et. al (WO 99/47525, US 6,410,480) is **NOT** prior art under 103(a)/102(e), (f), or (g). The WO 99/47525 application was filed March 3, 1999; and is not available as prior art under the revisions of the American Inventors Protection Act of 1999.

Under pre-AIPA law, which applies in this case, WO 99/47525 has a publication date of September 23, 1999, which is **after the filing date** of the present application. The present application has an effective filing date of September 7, 1999 (i.e. before the publication of the cited reference).

Withdrawal of Muhlebach et al. as a cited reference is respectfully requested. However, Applicants will address the rejections based on Muhlebach et al.

Page 2, paragraph 4 and page 3, paragraphs 5-6. The Examiner states that the disclosure does not contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity.

In the '480 patent (beginning at column 76, line 51), there is provided a comparison of Compound 1.01, which falls within the scope of formula I of the present application, and the compound closest to Compound 1.01 taught in the '480 patent. This data clearly demonstrates unexpectedly improved results obtained by the compounds encompassed by formula I of the present invention compared to the closest prior art compounds.

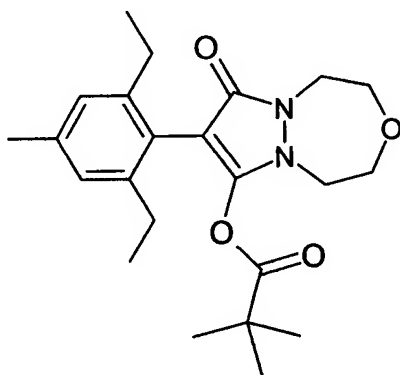
WO 98/13361 fails to disclose mixtures of their inventive compounds, which are different from the presently claimed herbicides, with co-herbicides at all. On page 32 of the WO reference, it is taught that the compositions of the reference "can also comprise ... other active substances." No discussion or mention of co-herbicides is provided. The data clearly demonstrate the unexpectedly improved herbicidal properties obtained by compounds of formula I of the present invention compared to the closest compositions taught in the cited prior art. Accordingly, mixtures of compounds of formula I with a select list of co-herbicides should also be considered unexpected and non-obvious. The unexpected benefits obtained by mixing herbicides of formula I and the select list of co-herbicides of the present invention are demonstrated in the Examples on pages 39-44 of the present application.

Muhlebach teaches: **safeners** + herbicides of instant formula I; Tobler et al teaches **safeners** + herbicides different from those of instant formula I as recited in claim 1. How can a combination of these references lead to synergistic mixtures of herbicides of instant formula I with **co-herbicides**, which are not mentioned in either reference?

Page 3, paragraphs 7 and 8; page 4, paragraphs 9-14. The Examiner states "both the references cited above teach combinations of pyrazilinnone compositions of formula I as safeners as presently claimed which embraces Applicants' claimed invention."

Contrary to the Examiner's assertion, compounds of the present invention encompassed by formula I are herbicides and are not taught or reasonably suggested by either of the cited references. Specifically, the compounds encompassed by formula I of the present invention are characterized by (1) the bivalent chain formed by the substituents R₄ and R₅ and (2) the methyl group in the para-position of the phenyl ring. The compounds represented by formula I of the present invention represent a selection from the broader teachings of WO 99/47525 (US 6,410,480), which is not available as a prior art reference.

A primary difference between the compounds of the present invention and those in the '480 patent and WO 98/13361, is that in the compounds of the present invention, R₄ and R₅ **together** are a group containing -O-, as illustrated below by the structure of compound no. 1.008:



The Examiner states in paragraph 8 (page 3) that Tobler et al. teach an antidote compound of formula (I) and their combination with a herbicidally effective amount of a herbicide such as sulfonylureas; especially formula V when A2 and B2 can be hydrogen and alkoxyalkyl group; and that these substituents are the same as R₄ and R₅ in claim 1 of the present invention.

The Examiner has misunderstood the novel compounds of the present invention where R4 and R5 **together form** a bivalent radical such as -CH₂CH₂-O-CH₂CH₂-, which is different from A2 and B2 **can be** hydrogen and alkoxyalkyl group. It is clear from these descriptions that A2 and B2 do not form an alkoxyalkyl group, but that they can each be either hydrogen and/or an alkoxyalkyl group. A2 and B2 are not the same as R4 and R5 in claim 1 of the present invention.

Page 5, paragraph 15. The Examiner has again asked what the proviso at the end of claim 1 disclaims. Applicants answered this in the last response to the previous Office Action as follows:

The proviso in claim 1 excludes those compounds of the formula I which gave unsatisfactory results in the tests carried out with the inventive compositions. No prior art is disclaimed by this proviso.

In Summary:

Mühlebach et al. is not available as a reference since it had not yet been published when the present application was filed.

Tobler et al. teach that certain herbicides, among them compounds which are similar to (but not the same as) the inventively used ones with regard to chemical structure, can be safened by the compounds of the formula I. Note that the pyrazoline compounds according to Tobler et al **do not contain** the inventively used CH₂CH₂-O-CH₂CH₂ group, using substituents A2 and B2 (see page 37 of this reference, the Examiner in this respect refers to an alkyoyalkyl group which, as a monovalent substituent, is, of course, **different** from said bivalent CH₂CH₂-O-CH₂CH₂ group formed by R4 and R5 together). Further, the safeners disclosed in this reference are different from the inventively used ones.

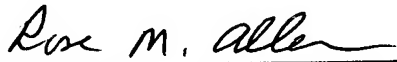
Although Applicants do not consider Muhlebach et al. as an available reference, the combined teachings of Mühlebach et al. and Tober et al. fail to render obvious the claimed compositions. Instant claim1 refers to a combination of the herbicides of the formula I with certain co-herbicides. The combined teachings of the references are silent of such combinations as the referential combined teaching compulsorily requires the presence of the safeners of the formula I. Further, the safeners used in Tobler et al are different from the inventively used ones. In view of the explanations given on page 1 of the present specification which reflect the general understanding in the art of the use of safeners, one cannot conclude that these safeners of the formula I, which work in combination with the herbicides described in Tobler et al, can successfully be used in combination with the inventively used herbicides. Thus, the finding of safeners for the instantly used herbicides is unobvious over the teachings of the cited art.

In view of the above arguments, Applicants respectfully submit that the rejection of claims 1-7 under 35 U.S.C. §103(a) has been overcome and hereby request that this application be passed to issue.

Enclosed herewith is a Notice of Appeal for the Final Rejection of claims 1-7.

Respectfully submitted,

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